REMARKS

The Examiner did not attach to the Office Action a signed copy of the Form PTO-1449 (attached herewith) filed with Applicants' Information Disclosure Statement of December 10, 2002. Applicants respectfully request the Examiner provide an initialed copy of the Form PTO-1449 to the undersigned.

In this Amendment, Applicants have amended claims 7 and 21 to add --a hydroxyalkyl group-- in the Markush listing. This amendment is supported, for example, by Compound No. 15 in the specification and claim 10.

Claims 7, 10 and 21 have been amended to replace "an aryl group" with --a phenyl group which may be substituted--. This amendment is supported, for example, by Compounds Nos. 37, 39-47, 49 and 55-58.

No new matter has been added and entry of this Amendment is respectfully submitted to be proper. Upon entry of this Amendment, claims 1-12, 14-18, 20 and 21 are all the claims pending in the application.

At page 3 of the Office Action, claims 1-12 and 21 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the combined teachings of Gregory et al (Bioorganic & Med. Chem. Letts., 10(6), 2000, 527-29) and Giani et al (US 4,971,980).

Gregory et al was published in 2000. Accordingly, Applicants respectfully submit that Gregory et al is prior art, if at all, under § 102(a).

Applicants have herewith submitted a verified English translation of the priority document, JP (Hei) 11-181142, which was filed on June 28, 1999. Applicants submit that all of the present claims are supported by the priority document (see claims 1-12).

Applicants submit that Gregory et al cannot be proper prior art, because the present application has a priority date prior to the publication date of Gregory et al. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection over the combined teachings of Gregory et al and Giani et al.

At page 5 of the Office Action, claims 1, 7, 10, 12 and 21 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which is not described in the specification.

It was asserted that the meaning of "aryl" recited in claims 7, 10 and 21 is unclear. It was further asserted that indefiniteness of claims 7, 10 and 21 causes overlap.

It was also asserted that the examples do not provide adequate support for claim of all aryl radicals in R^{13}, and there are no carbon limits on aryl.

It was further asserted that the examples do not provide adequate support for claim of all acyl radicals in R^2 and R^{12}.

It was asserted that no indication was given as to what the substituents or acyl groups really are, with regard to the expressions "R^3 and R^{13} represents one or more...nitrogen atom" and "acyl" in claims 1, 7, 10, and 21.

Applicants respectfully submit that there is sufficient written description in the specification for the present claims as amended.

Regarding the definition of "aryl", an aryl group is one derived from an arene (aromatic hydrocarbon) by removal of a hydrogen atom, and a heterocyclic compound represents a

molecule wherein an element other than carbon is present in the ring. Accordingly, there is no reasonable ground for asserting that an aryl group can be heterocyclic.

We are not entirely clear what the Examiner meant by "indefiniteness of claims 7, 10 and 21 causes overlap." We believe that the Examiner meant that claims 7, 10 and 21 overlap in scope. In this case, Applicants respectfully submit that there is no rule against claims which overlap in scope.

Claim 7 is directed to a benzimidazole compound represented by the formula (II) or a salt thereof, wherein R^{11} represents one or more functional groups on the benzene ring selected from the group consisting of a hydrogen atom, a halogen atom, a lower alkyl group, and a lower alkoxy group; R^{12} represents a hydrogen atom, an alkyl group, or an acyl group; R^{13} represents one or more functional groups on the piperidine ring selected from the group consisting of a hydrogen atom, an alkyl group, a hydroxyalkyl group, a phenyl group which may be substituted, a hydroxy group, an alkoxy group, an amino group, an acyl group, a cyano group, a carbamoyl group and an alkoxycarbonyl group; L^1 represents a C_4-C_8 alkylene group; and X represents O, S or methylene group;

Claim 10 is directed to the compound or a salt thereof according to claim 7, wherein R^{13} is a functional group selected from the group consisting of a hydrogen atom, an alkyl group, a hydroxyalkyl group, a phenyl group which may be substituted, a hydroxy group, and a cyano group; and

Claim 21 is directed to a pharmaceutical composition comprising a compound as defined in claim 7.

Claim 10 depends from claim 7 reciting a narrower Markush group in R^{13}. Claim 21 recites the same compound as defined in claim 7 as an active ingredient of a pharmaceutical composition. Accordingly, all claims 7, 10 and 21 are proper.

Regarding the recitation of aryl radicals in R^{13}, Applicants respectfully submit that there is ample support in Applicants' specification, for example, Compounds No. 39-47, 49 and 55-58.

Regarding carbon limits on aryl in claim 7, 10 and 21, Applicants are not required to limit the scope of claims to the specific examples disclosed in the specification, provided that the recitation is supported by the disclosure of the specification (for example, page 3, lines 13-14).

Nonetheless, in this Amendment, Applicants have amended claims 7, 10 and 21 to replace "an aryl group" with --a phenyl group which may be substituted--.

Regarding the recitation of an acyl group in R^2 and R^{12} in claims 1 and 7, respectively, Applicants respectfully submit that Compound No. 15 is a compound having an acyl group in R^{12}.

Regarding R^2 in claim 1, again, Applicants are not required to limit the scope of the claim to the specific examples disclosed in the specification, provided that the recitation is supported by the disclosure of the specification (for example, page 3, lines 1-2).

Regarding the recitation of R^3 and R^{13}, Applicants respectfully submit that they are clear.

The Examiner appears to misunderstand claim 1. In claim 1, R^3 is defined as "one or more functional groups *on the ring containing the nitrogen atom* and A," but not "one or more...nitrogen atom."

In claims 7, 10 and 21, R^{13} is defined as "one or more functional groups selected from the group consisting ... an acyl group ...." Therefore, the scope of R^{13} is narrower than that of R^3. Applicants respectfully submit that an acyl group is a RCO- substituent.

In view of the above, the Examiner is respectfully requested to reconsider and withdraw the rejection.

At page 7 of the Office Action, claims 1 and 12 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

It was asserted that the terms contained in claims 1 and 12 are "open ended because it allows for the inclusion of other active ingredients."

Applicants respectfully traverse the rejection.

Regarding claim 1, Applicants submit that claim 1 is directed to a compound or a salt thereof, rather than a pharmaceutical composition.

Regarding claim 12, we are not entirely clear what are the reasons for the rejection. Claim 12 is directed to a pharmaceutical composition, comprising the presently claimed compound as an active ingredient.

Applicants respectfully submit that claim 12 is definite because it defines the scope of the invention as to include any pharmaceutical composition comprising the presently claimed compound as an active ingredient.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

Fang Liu
Registration No. 51,283

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373
PATENT TRADEMARK OFFICE

Date: March 18, 2003